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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,136	10/23/2000	Herbert M. Straub	20003	9008

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

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DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-5

Office Action Summary

Application No.

09/694,136

Applicant(s)

STRAUB ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-8-02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed July 08, 2002.

Claims 1-20 were amended and are pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suess et al. (U.S. 5,985,078) in view of Abrams (U.S. 5,908,527).
4. Suess discloses a metallic embossing foil (abstract) with carrier material that transfers colored layers on a surface (column 3, lines 42-44) conventionally used to wrap articles. Suess discloses a transparent layer applied to the colored layer applied by means of transfer foils which comprise a carrier film which are releasably disposed thereon to a hot embossing foil (column 3, lines 62-67). The reference discloses rolling a molded foil (column 4, lines 33-35) where the colored layer gives the foil a decorative pattern (column 4, lines 56-58 and column 7, lines 14-16). Suess discloses an adhesive

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layer on the foil (column 5, line 1). Suess does not disclose that the foil is used in foil wrapping of a substrate or as picture frame element or building trim piece.

These features are directed to intended use of the claimed invention, which is given little patentable weight. Suess does not disclose the foil being laminated. Additionally the foil of Suess is used to wrap articles. Picture frame elements and building trim pieces are articles and so are included by the reference.

Abrams teaches a printed foil laminate (abstract and column 2, lines 12-15).

Suess and Abrams are analogous art because they are from the same field of foils. It would have been obvious to one of ordinary skill in the art to laminate the embossed foil of Suess because Abrams teaches laminated foils maintain composure better during the rolling process.

Claim Rejections – 35 USC § 103(a)

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams (U.S. 5,653,844) in view of Nelson (U.S. 4,724,026).

6. Abrams discloses a foil laminate with transfer printing (abstract) with impressions in the laminate (column 2, lines 4-5) leaving a decorative pattern with a suitable adhesive. Abrams discloses the molded foil laminate suitable to roll (column 2, lines 51-58 and column 4, lines 56-57) suitable to cover various packaging articles (column 7, lines 8-9). Abrams discloses a dry bond adhesive layer with an opaque colored material (column 7, lines 27-44). Suess does not disclose that the foil is used in foil

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wrapping of a substrate or as picture frame element or building trim piece. These features are directed to intended use of the claimed invention, which is given little patentable weight. Additionally the foil of Abrams is used to wrap articles. Picture frame elements and building trim pieces are articles and so are included by the reference.

Abrams does not disclose carrier stripped from the foil or clear and opaque properties.

Nelson teaches a metallic foil with a transfer sheet stripped away leaving a decorated sheet on the foil (column 2, lines 40-50) along with a clear or colored coating, a release coat and a carrier film (column 3, lines 39-42) on the foil. Abrams and Nelson are analogous art because they are from the same field of foils. It would have been obvious to one of ordinary skill in the art to include the carrier and release layers with clear or colored coatings in the foil laminate of Abrams because Nelson teaches these layers improve the decorative properties of the film rendering the foil more marketable.

Response to Arguments

7. Applicant's arguments of rejection under 35 USC 112, second paragraph have overcome the rejection due to amending claims 1-10 to render the claims definite.

Applicant's arguments of rejection under 35 USC 103(a) as unpatentable over Suess et al. (U.S. 5,985,078) in view of Abrams (U.S. 5,908,527) have been considered but are unpersuasive. Applicant argues the printed hot transfer foil etched by Suess is merely one of a multitude of hot transfer foils and is a lacquer, which is more commonly called an 'ink'. Applicant further argues the metallic foil is only recited as a carrier along

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with plastic carriers, not as the transfer coat. Examiner would like to direct Applicant's attention to column 3, lines 62-67 of Suess, disclosing a layer applied to a color layer by means of transfer foils which comprise a carrier film and are releasably disposed thereon to a hot embossing foil. Regardless of the argument, Suess in fact discloses a decorative film (column 4, lines 56-58) comprising a hot transfer foil which comprise a carrier film releasably disposed thereon to a hot embossing foil, where the molded foil is rolled (column 4, lines 33-35). Applicant argues embossing foils of Suess have a different function than that of the claimed invention, however Suess clearly discloses a hot embossing foil which is the same as in the instantly claimed invention, absent supported evidence by Applicant. Applicant seems to be interpreting the embossing foil of Suess as a common practice of transferring an ink or lacquer to a machine face, however fails to link the embossing foil of Suess to this practice according to the description of Suess's invention. Applicant argues the decorative pattern referred to in Suess cannot be asserted to include all decorative patterns as such an assertion would be greatly broadening the disclosure of Suess. Examiner disagrees because the decorative patterned film of Sues is no broader than Applicant's decorative patterned film and therefore has the same encompassing capability as that of the claimed invention. Applicant argues Suess does not decorate another decorative film. The film of Suess is conventionally used to wrap articles, which means the decorative film of Suess can be used to decorate another decorative film. Applicant alleges the improvement of Suess is to etch the outer layer(s) after transferring the ink and removing the carrier while the claimed invention provides a decorative wrapping film where the top coat *may*

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have been previously applied to the wrapping film, meaning that this limitation does not necessarily occur. Applicant argues the commonly known foils described in Sues are used to etch the outer layer but are used by Applicants to decorate another decorative surface, that is whether the film has a top coat or not. This argument is directed to the intended use of the reference and the claimed invention which is given little patentable weight. Applicant argues Abrams '527 uses the term 'foil' in the common sense of an aluminum foil sheet. Abrams '527 is used to support the conventionality of a printed foil laminate. Because, as Applicant indicates, Abrams teaches a multilayered laminate wherein both sides have printing thereon where one surface is adhered to another, it meets the limitations of the claimed invention. Applicant argues neither Abrams '527 nor '844 have a decorative wrapping film as it has no decoration. Because Abrams '844 discloses a foil laminate with transfer printing (abstract) with impressions in the laminate (column 2, lines 4-5) the foil in fact, does have a decoration.

Applicant's arguments of rejection under 35 USC 103(a) as unpatentable over Abrams (U.S. 5,653,844) in view of Nelson (U.S. 4,724,026) have been considered but are unpersuasive. Applicant argues Abrams '844 is an aluminum foil laminate and not a decorative wrapping film. Examiner disagrees because Abrams '844 discloses a foil laminate with transfer printing (abstract) with impressions in the laminate (column 2, lines 4-5) the foil in fact, does have a decoration. Applicant argues Nelson uses commercially available hot transfer foil where the hot transfer foil is a metallic pigmented hot transfer foil in place of ink layers and is not used as a wrapping film. Applicant argues Nelson is only a printed sheet. Examiner disagrees because Nelson teaches a

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a metallic foil with a transfer sheet stripped away leaving a decorated sheet on the foil (column 2, lines 40-50) along with a clear or colored coating, a release coat and a carrier film (column 3, lines 39-42) on the foil, meaning it is directed to more than simply a printed sheet.

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

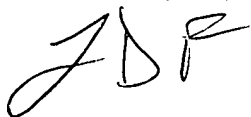
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISOR, PATENT EXAMINER
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